

## REMARKS

The Examiner is thanked for indicating that claims 3-9, 11, and 21-24 are allowable if rewritten in independent form and the §112 rejections are overcome.

Claims 1, 2, 4-15, 17-20, 22-25, and 27-29 remain pending in the instant application. Claims 1, 2, 10, 12-20, 25, and 26 presently stand rejected. Claims 1, 2, 4, 7, 11-15, 17-20, 22, 25, and 27-29 are amended herein. Claims 3, 16, 21, and 26 are hereby cancelled without prejudice. Entry of this amendment and reconsideration of the pending claims are respectfully requested.

### *Claim Objections*

Claims 1, 11, 12, 17, 22, 25, and 25-29 are objected to for various informalities. Accordingly, these claims have been amended to address the Examiner's concerns.

### *Claim Rejections – 35 U.S.C. § 112*

Claims 1, 12-18, 20, 25, and 26 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Applicants have amended the claims to address many of the Examiner's concerns with the following exceptions. Applicants respectfully disagree that claims 1 and 12 are incomplete for omitting essential steps.

“A claim which **omits matter** disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, **first paragraph**, as not enabling.” M.P.E.P. § 2172.01 (emphasis added). “A claim which fails to **interrelate** essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, **second paragraph**....” M.P.E.P. 2172.01 (emphasis added). Applicants assume for the purposes of this response that the Examiner intended to issue the instant rejection either (1) under §112, first paragraph, for failure to omit an essential element, or (2) under §112, second paragraph for failure to interrelate essential elements.

Applicants respectfully disagree that claims 1 and 12 fail to recite essential matter or interrelate essential elements. Essential matter is “matter **disclosed to be essential** to the invention as **described in the specification** or in other statements of

record...” M.P.E.P. § 2172.01 (emphasis added). Essential elements are those elements “**defined by applicant(s) in the specification...**” to be essential. *Id.*

Applicants note that the specification does not state that process blocks 335, 340, or 345 illustrated in FIG. 3 are “essential” and have made no such statement otherwise. In fact, the specification expressly states, “FIG. 3 is a flow chart illustrating a process 300 for generating and for transmitting data slices 240 with in optical cells 260, **in accordance with an embodiment.**” Accordingly, FIG. 3 merely illustrates one embodiment, not necessarily the only embodiment, and certainly does not indicate that process blocks 335, 340, and 345 are essential. MPEP § 2172.01 requires that essential matter be “disclosed to be essential to the invention” either in the specification or in other statements of record. No such statements have been made.

Furthermore, the Office Action states that process blocks 335, 340, and 345 are “required for getting data slices onto the network.” However, claim 1 merely recites that the data slices are scheduled “**for** transmission onto an optical switching network.” No portion of claim 1 recites the action of “transmitting the data slices onto the network.” Therefore, these “steps” for transmitting the slices onto the network cannot be essential, since claims 1 and 12 don’t even recite transmitting the data slices onto the network. Accordingly, Applicants respectfully request that the instant §112 rejections of claims 1 and 12 be withdrawn.

#### *Claim Rejections – 35 U.S.C. § 101*

Claims 12-18 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 12-18 have been amended to address the Examiner’s concerns.

#### *Claim Rejections – 35 U.S.C. § 102*

Claims 1, 2, 10, and 12-14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ovadia (US Patent 7,277,634).

Claims 1, 12, 18, and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pearson (US Patent 5,477,364).

A claim is anticipated only if each and every element of the claim is found in a single reference. M.P.E.P. § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the claim.” M.P.E.P. § 2131 (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989)).

Independent claim 1 has been amended to include subject matter of dependent claim 3 (now cancelled) deemed allowable by the Examiner. Accordingly, claim 1 now includes allowable subject matter.

Independent claim 12 has been amended to include similar subject matter as independent claim 12.

Independent claim 19 has been amended to include subject matter of dependent claim 21 (now cancelled) deemed allowable by the Examiner. Accordingly, claim 19 now includes allowable subject matter.

Consequently, the prior art of record fails to disclose each and every element of claims 1, 12, and 19, as required under M.P.E.P. § 2131. Accordingly, withdrawal of the instant § 102 rejections of claims 1, 12, and 19 is requested.

The dependent claims are novel over the prior art of record for at least the same reasons as discussed above in connection with their respective independent claims, in addition to adding further limitations of their own. Accordingly, Applicants respectfully request that the instant § 102 rejections of the dependent claims be withdrawn.

#### *Claim Rejections – 35 U.S.C. § 103*

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pearson (US Patent 5,477,364) in view of Xu et al.(US Patent Application Publication US 2002/0071149 A1).

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03.

Independent claim 25 has been amended to include the subject matter of dependent claim 26. Applicants note that dependent claim 26 was not rejected under

either §103 or §102. Accordingly, Applicants assume the Examiner deemed the subject matter of dependent claim 26 to be both novel and nonobvious.

Consequently, the prior fails to teach or suggest all elements of claim 25, as required under M.P.E.P. § 2143.03. Accordingly, Applicants request that the instant §103(a) rejections of claim 25 be withdrawn.

### **CONCLUSION**

In view of the foregoing amendments and remarks, it is believed that the applicable rejections have been overcome and all claims remaining in the application are presently in condition for allowance. Accordingly, favorable consideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to telephone the undersigned representative at (206) 292-8600 if the Examiner believes that an interview might be useful for any reason.

### CHARGE DEPOSIT ACCOUNT

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a). Any fees required therefore are hereby authorized to be charged to Deposit Account No. 02-2666. Please credit any overpayment to the same deposit account.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

Date: December 17, 2007

/Cory G. Claassen/

Cory G. Claassen  
Reg. No. 50,296  
Phone: (206) 292-8600

1279 Oakmead Parkway  
Sunnyvale, CA 94085-4040